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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,433	09/19/2008	Kevin D. Cooper	CASEP0931WOUS	8758
7590 11/21/2011 John T. WIEDEMANN Calfee ,Halter & Griswold LLP 1400 McDonald Investment Center 800 Superior Avenue Cleveland, OH 44114-2688			EXAMINER WARD, PAUL V	
			ART UNIT 1624	PAPER NUMBER
			MAIL DATE 11/21/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,433	Applicant(s) COOPER ET AL.	
	Examiner PAUL V. WARD	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 3-6,9-11,16-19,22-24,26-29,31 and 32 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 3-6,9-11,16-19,22-24,26-29,31 and 32 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/5/11</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

STATUS OF THE CLAIMS: Claims 3-6, 9-11, 16-19, 22-24, 26-29 and 31-32 are pending in this application.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 3-6, 9-11, 16-19, 22-24, 26-29 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Vorozhtsov et al. (CHEM ABSTRACT 2002).

Vorozhtsov discloses phthalocyanine compounds and compositions use for treating tumors and using said compounds in PDT. (See Abstract). These compounds, compositions and methods read on the instant claim. . Since Vorozhtsov teaches the exact compounds, compositions and methods, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

2. Claims 3-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Capraro et al. (US Patent 5,358,940).

Capraro discloses phthalocyanine compounds and compositions use for treating epithelia cancer and for use in PDT. (See pages 10-19 and Examples). These

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compounds, compositions and methods read on the instant claim. Since Capraro teaches the exact compounds, compositions and method, Applicant's claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

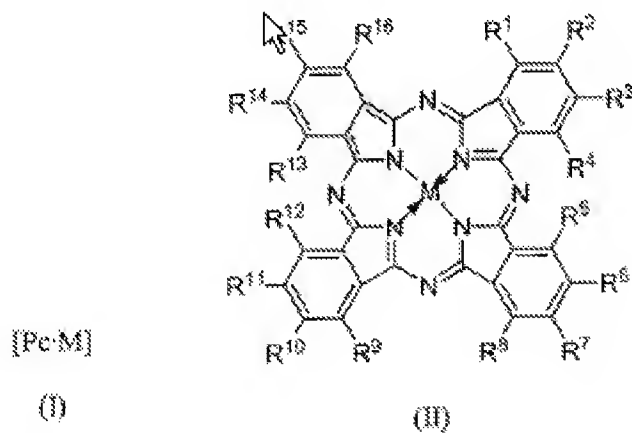
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vorozhtsov et al. (CHEM ABSTRACT 2002).

Applicants claim phthalocyanine compounds and compositions of formula I & II:



wherein all the variables are defined in the claim. Additionally, Applicant claims a method for treating epithelial cancer using said composition.

Vorozhtsov discloses a generic group of phthalocyanine compositions and a method of treating epithelial cancer, which embraces Applicants' claimed compounds

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and methods. (See Abstract). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

4. Claims 3-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capraro et al. (US Patent 5,358,940).

Capraro discloses a generic group of phthalocyanine compositions and a method of treating epithelial cancer, which embraces Applicants' claimed compounds and methods. (See columns 1-7 and formula I and Examples). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties, and

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thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. Thus, Applicant's claims are obvious, and therefore, rejected under 35 U.S.C. 103.

Conclusion

Claims 3-6, 9-11, 16-19, 22-24, 26-29 and 31-32 are pending. Claims 3-6, 9-11, 16-19, 22-24, 26-29 and 31-32 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/PAUL V WARD/

Primary Examiner, Art Unit 1624